

UNITED STATES PATENT & TRADEMARK OFFICE

Application No. : 09/690,409

Title : APPARATUS FOR APPLYING DRINKING STRAWS

Applicant : Hans-Peter WILD, *et al.*

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Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

REPLY BRIEF

Sir:

Applicants submit this Reply Brief in response to the Examiner's Answer mailed June 9, 2009, in which the Examiner maintained the prior rejection of claims 7, 9, and 11-14, all the claims pending in the subject Application. Appellant hereby requests reversal of the Examiner's Rejection for the reasons given in this Reply Brief and in the Appeal Brief. The filing of this Reply Brief is timely as the due date under MPEP §1208 and Bd.R. 41.41(b) is August 10, 2009 (August 9, 2009 being a Sunday). No fee is believed due with this Reply Brief,

however, the Commissioner is hereby authorized to charge any further fees or deficiencies in fees to Deposit Account No. 19-4709.

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III. STATEMENT OF ADDITIONAL FACTS

A statement of additional facts is not required as all pertinent facts were set forth in the Appeal Brief, which is fully incorporated herein.

IV. ARGUMENT

The following arguments are in response to the Examiner's Answer, which appears to maintain the same grounds for rejection as the Final Office Action. However, to the extent that the rejection of the claims on appeal are based on arguments not previously stated, Applicants do not concede the appropriateness of such rejections.

A. THIS REJECTION ON THE GROUND OF NONSTATUTORY OBVIOUS-TYPE DOUBLE PATENTING OVER CLAIMS 1, 3, 7, 9, 10, 12, 15 AND 17 OF U.S. PAT. NO. 6,681,547 TO WILD IN VIEW OF U.S. PAT. NO. 4,584,046 TO GEYSSEL IS MOOT.

Without conceding the appropriateness of the rejection, in the interest of simplifying the issues on appeal, Applicants have submitted a terminal disclaimer with respect to U.S. Pat. No. 6,681,547 to Wild concurrently herewith to overcome this rejection in accordance with MPEP §804.2. Accordingly, Applicants respectfully submit that this rejection is now moot.

B. REJECTION UNDER 35 U.S.C. §103(A) - U.S. PAT. NO. 4,584,046 TO GEYSEL IN VIEW OF U.S. PAT. NO. 4,572,758 TO WILD.

Claims 7, 9, and 11-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,584,046 to Geyssel (hereinafter “Geyssel”) in view of U.S. Pat. No. 4,572,758 to Wild (hereinafter “Wild”). Applicants respectfully maintain, however, that the invention claimed by independent claims 7, 9, 11, and 13-14 and dependent claim 12 of the subject application is not obvious in view of Geyssel or Wild, either taken alone or in combination.

In response to the Examiner’s Answer, Applicants maintain that the claimed invention is not rendered obvious by any combination of Geyssel and Wild at least because (1) no *prima facie* case of obviousness has been established as neither the Final Office Action dated July 15, 2008 (hereinafter the “Final Office Action”) nor the Examiner’s Answer provide any objective teaching in the prior art or point to any knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references; (2) the Examiner’s Answer mischaracterizes the cited references and the cited references do not in fact teach or suggest each and every element as claimed; and (3) a *prima facie* case of obviousness cannot be established because one of ordinary skill in the

art would have no reason to combine Geyssel and Wild to achieve the claimed invention. Each of these arguments is set forth below.

As a preliminary matter, page 7 of the Examiner's Answer states:

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

This statement is without any significance in the context of these proceedings. Applicants' arguments do not implicate reading any limitations from the specification of the cited references into the claims. Rather, the issues before the Board are (1) whether a person of ordinary skill in the art would have combined Geyssel and Wild to achieve the claimed invention; and (2) assuming that a *prima facie* case of obviousness can be established, whether Geyssel and Wild teach or suggest each and every element of the claimed invention. Applicants submit that both questions are properly answered in the negative.

1. The Final Office Action and Examiner's Answer Both Fail To Establish A *Prima Facie* Case Of Obviousness Because No Rationale Is Provided That Explains Why The Claimed Invention Would Have Been Obvious To A Person Of Ordinary Skill In The Art At The Time Of The Invention.

Page 10 of the Examiner's Answer states:

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason

why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 [sic] USPQ 209 (CCVA [sic] 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

However, the Examiner's Answer, like the Final Office Action, fails to support a *prima facie* case of obviousness. The M.P.E.P. states:

The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.

M.P.E.P. §2143.

Moreover, this Board has ruled that:

The [e]xaminer can satisfy [his burden of establishing a *prima facie* case of obviousness] **only** by showing some objective teaching in the prior art or that the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”

Ex parte Coppeta, Appeal 20084898, decided Feb. 5, 2009 (citing *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992)) (emphasis added).

Here, no *prima facie* case of obviousness has been articulated. The Examiner's Answer states that an explicit articulation of "a motivation to make the modification" is unnecessary and, of course, none is articulated in the Examiner's Answer. Critically, the Examiner's Answer overlooks the fact that no explanation that might support a conclusion of obviousness, which is required, has been articulated. According to the above-cited precedent of this Board, a *prima facie* obviousness rejection cannot stand without such support. Moreover, as discussed below, the absence of such support is not surprising, since the Geyssel and Wild citations, whether taken alone or in combination, cannot achieve the claimed invention.

2. A *prima facie* case of obviousness cannot be established because one of ordinary skill in the art would not achieve the claimed invention by any combination of Geyssel and Wild.

The Examiner's Answer maintains the Final Office Action's reliance on Geyssel and Wild. For instance, page 4 of the Examiner's Answer states:

Geyssel discloses (figures 1-10) an apparatus and a method comprising:

providing a plurality of straw packages from above the conveyor belt (Fig. 1 of Geyssel clearly shows that the straw packages are located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package onto the second side wall at an acute angle to the conveyor belt (figures 1 and 6 of Geyssel - column 4, lines 62-68 and column 5, lines 1-14);

Page 5 continues:

Geyssel clearly teaches and suggests the apparatus and method steps in which: the bag (12) includes the bag as recited in the Applicant's present claimed invention, and the drinking straws can be applied to the bag (of any design configuration - shapes and material) at any desired angular position with respect to the conveyor surface.

Page 6 continues:

Geyssel discloses the claimed invention, but it does not expressly disclose the straw packages having an adhesive thereon and a cover strip covering the adhesive.

Wild discloses an apparatus and a method comprising: the straw packages having an adhesive thereon and a cover strip covering the adhesive (column 2, lines 22- 29) in which the adhesive strip (29) is applied on the straw package (12) prior to the step of applying the straw package onto the second side wall of the container (bag). Wild provides "*a process and apparatus for increasing the yield of straws affixed to beverage containers by providing an adhesive on the straw packages*" (Wild – column 2, lines 46-49) (emphasis in original).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and

method by incorporating the apparatus and method as taught by Wild to provide a more effective machine and method of attaching drinking straws onto containers.

However, there is no reason one of ordinary skill in the art would combine Geyssel and Wild to arrive at the claimed invention because neither reference is capable of solving the problems resolved by the claimed invention. Furthermore, even assuming *arguendo* there would be a reason to combine Geyssel and Wild, these references do not, alone or in combination, teach each and every element as claimed at least for the reasons set forth in the Appeal Brief and because the Examiner's Answer mischaracterizes Geyssel, as discussed below.

a. The Examiner's Answer's reliance on Geyssel is misplaced because the Examiner's Answer mischaracterizes Geyssel.

In multiple instances, the Examiner's Answer asserts that Geyssel provides for a depressing arm that displaces downward toward the conveyor belt. For example, page 4 of the Examiner's Answer states (emphasis added):

Geyssel discloses (figures 1-10) an apparatus and a method comprising:

providing a plurality of straw packages from above the conveyor belt (Fig. 1 of Geyssel clearly shows that the straw packages are located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a transfer drum (20) above the conveyor belt, the transfer drum being rotatable about an axis substantially parallel to the second side wall (Fig. 1 of Geyssel clearly shows that the transfer drum is located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a lever having a depressing arm (41a) and a pivoting arm (49);

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package onto the second side wall at an acute angle to the conveyor belt (figures 1 and 6 of Geyssel - column 4, lines 62-68 and column 5, lines 1-14);

However, Geyssel does not contemplate or teach or suggest a depressing arm as claimed. Contrary to the Examiner's Answer's assertion, Fig. 1 of Geyssel does not support the Examiner's contention "that the straw packages [and the transfer drum] are located on a higher elevation than the conveyor belt with respect to the ground." Rather, it shows that the straws are level with the packages receiving the straws, as depicted in Figs. 2 and 7-9, because the wheel must be aligned according to the height of the package so as to place the straw in the proper diagonal position on the package (col 6, rows 18-23).

Also, as depicted in Fig. 6, the applicator arm 41 of Geyssel is directed to a two arm tilt lever operated by a spring and air nozzle that provides bursts of

compressed air (col 4, rows 62-68, col 5, rows 1-14) to cause the arms to press the straw against the package that is “moving directly in **front** of it” (col 5, row 27) (emphasis added). Thus, Geyssel is directed to applying straws to the packages from the side rather than the top and does not teach and has no reason to suggest the use of a depressing arm that exerts a downward motion as claimed.

Additionally, page 5 of the Examiner’s Answer states:

Applicant's present claimed invention, and the drinking straws can be applied to the bag (of any design configuration - shapes and material) at any desired angular position with respect to the conveyor surface.

Page 9 of the Examiner’s Answer concludes:

Geyssel clearly teaches and suggests that the apparatus and method discloses by Geyssel can accommodate the containers of any material and shapes (*packages, bottles, bags, etc.. & packages, bottles or other objects*) and those containers can be placed on the conveyor in any desired angular position - in other words, the container can be placed on the conveyor from an upright position all the way down to laying with one side flat on the conveyor.

. . . the straw applicator [of Geyssel] is designed to be tipped in any desired angular position as well to accommodate the various containers (of any kind of material and shapes) which can be positioned on the conveyor in any desired angular position – in other words, the depressing arm of [Geyssel] (apparatus and method) is fully capable of being displaced downward toward the conveyor belt as recited.

The Examiner's Answer asserts that because Geyssel is directed to a carrier 14 that may be tilted in two directions, the applicator arm 41 is capable of being displaced downward toward the conveyor belt. This is unsupported and contrary to Geyssel. Geyssel only makes a single, vague statement that "the applicator element can be placed in any desired **angular position** against the objects to which the [straws] are to be secured" (col 2, rows 29-31) (emphasis added). While Geyssel is directed to tilting the carrier 14, it does not teach or suggest any rotation of carrier 14 such that the straws are applied to the packages from the top using a downward moving arm.

For example, as seen in Figs. 7-9 of Geyssel, the carrier 14 is tilted in a first direction, forming an acute angle with the horizontal, so that the straws may be applied in the proper diagonal orientation on packages of varying heights. Also, as shown in Fig. 9, the carrier 14 is tilted in a second direction, also forming an acute angle with the horizontal, to accommodate an upright package having an inclined surface, inclined at an angle of less than 90 degrees. However, there is no teaching or suggestion in Geyssel that the carrier 14 may be repositioned so that the wheel is suspended over the package, which would be required in order for the arm to have any potential of becoming a depressing arm. Moreover, doing so would

additionally mean that the applicator element no longer sits in an “angular position” (col 2, row 31). Thus, Geyssel does not teach or suggest a depressing arm as claimed.

- b. **One of ordinary skill in the art would have had no reason to combine or modify Geyssel and Wild because neither achieve the features or are capable of producing the benefits associated with the claimed invention.**

One of ordinary skill in the art has no reason to combine Geyssel and Wild to reach the claimed invention because the combination of Geyssel and Wild does not, in fact, yield the claimed invention and neither Geyssel nor Wild, separately or in combination, are capable of solving the problem addressed by the claimed invention.

Claims 7, 9, 11-12 and 14 are directed to lying the bags on their side on a conveyor belt and all the claims on appeal are directed to capturing at least the benefits associated with using a downward motion of the depressing arm and placing the adhesive on the straw packages rather than the foil bags themselves before affixing the straw packages to the foil bags. At least these claimed features provide benefits, such as improved adhesion of the straw package to the foil bag that are not found in either Wild or Geyssel. The claimed features also provide an overall greater manufacturing yield than can be obtained by either Wild or Geyssel,

taken alone or in combination. The prior art is incapable of providing similar benefits and does not teach each and every element of the claimed invention.

Additionally, there would be no reason for one of ordinary skill in the art to modify Geyssel as stated in the Examiner's Answer. Page 4 of the Examiner's Answer states:

Geyssel discloses (figures 1-10) an apparatus and a method comprising:

positioning a bag on a conveyor belt (13) so that the second side wall is at an acute angle with the conveyor belt (figure 9);

Page 5 of the Examiner's Answer continues:

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method to provide the foil bag (well known in the art) as recited in the claimed invention.

However, Geyssel does not teach or suggest positioning each of the foil bags on a conveyor belt in a lying position as claimed. Fig. 9, for example, depicts a package standing upright on a conveyor belt. Indeed, one of ordinary skill in the art would have no reason, and it would be nonsensical, to modify Geyssel so that foil bags are placed in the lying position as claimed because the straws of Geyssel

are attached to upright packages using a horizontal motion rather than a downward motion, as previously discussed.

Accordingly, not only would there have been no reason for one of ordinary skill in the art to combine or modify Geyssel and Wild, it would have been illogical to do so.

The Examiner's Answer also notes on page 12 that:

Furthermore, it would have been obvious to combine the references, since it has been held that applying a known technique to a known device would have yield predictable results to one of ordinary skill in the art at the time of the invention (*KSR*).

However, the Examiner's Answer overlooks the fact that the claimed invention does not apply a known technique to a known device and the achieved improvements are not predictable results. As discussed above, and in greater depth in Applicants' Appeal Brief, neither Geyssel nor Wild are capable of producing the results of the claimed invention. Furthermore, neither reference, alone or in combination, teach or suggest each and every element of the claimed invention. Thus, the claimed invention is not obvious.

V. CONCLUSION

Applicants respectfully submit that no *prima facie* case of obviousness has been established based on Geyssel in view of Wild because the Examiner's Answer fails to point to any evidence that a person of ordinary skill in the art would have reason to combine or modify Geyssel and Wild to obtain the invention as claimed and neither Geyssel nor Wild, alone or in combination, teach or suggest each and every element as claimed. At least for the reasons detailed above and in Applicants' Appeal Brief, Applicants respectfully maintain that the invention as claimed is patentable.

Applicants respectfully submit that claims 7, 9, and 11-14 in light of the arguments set forth above are in condition for immediate allowance. Accordingly, Applicants respectfully request that the rejections be reversed and the claims be allowed to issue.

No fee is believed due with this Reply Brief, however, Applicants authorize the Commissioner to charge any deficiencies to Deposit Account No. 19-4709, if necessary.

Respectfully submitted,

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